

Attorney Docket No. 57109 (71699)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: S. Denmeade, et al. Examiner: S. Liu
Application No.: 09/627,600 Group: 1653
Filed: July 28, 2000
For: ACTIVATION OF PEPTIDE PRODRUGS BY (HK2)

VIA HAND DELIVERY
MAIL STOP PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL LETTER

Transmitted herewith for filing in the above-referenced patent application are the following documents:

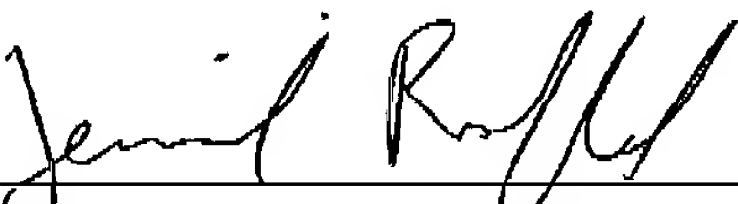
1. Petition to Withdraw Holding of Abandonment Under 37 C.F.R. § 1.181 (6 pages);
2. Exhibits A - F;
3. Copy of the Computer Readable Diskette containing the Sequence Listing, included as part of the copy of the Response to Notice to Comply filed July 18, 2002 (Exhibit B); and
4. This transmittal letter (1 page) (x2).

The Commissioner is hereby authorized to charge any excess fees that may be required, or credit any overpayment to Deposit Account No. 04-1105. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Date: July 9, 2003

By:


Jennifer K. Rosenfield, Reg. No. 53,531
Intellectual Property Practice Group of
Edwards & Angell, LLP
P.O. Box 9169
Boston, MA 02209
Tele: (617)-439-4444

Customer No. 21874

BOS2_341084.1

Attorney Docket No. 57109 (71699)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) S. Denmeade, et al.

EXAMINER: S. Liu

U.S.S.N.: 09/627,600

GROUP: 1653

FILED (U.S.): July 28, 2000

Conf. No. 3631

FOR: ACTIVATION OF PEPTIDE PRODRUGS BY (HK2)

VIA HAND DELIVERY

MAIL STOP PETITION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 C.F.R. § 1.181

Dear Sir:

Applicants submit the instant Petition pursuant to 37 C.F.R. § 1.181 to request withdrawal of the holding of abandonment of the instant application on the grounds that a response was timely filed by Applicants' Agent to the communication - a July 3, 2002 Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures (Paper No. 13) (hereinafter, "Notice") - from the U.S. Patent and Trademark Office (hereinafter, "USPTO") that formed the basis of the abandonment.

A comprehensive statement of the facts in support of the instant Petition is set forth immediately below.

Attorney Docket No. 57109 (71699)
U.S.S.N. 09/627,600
Filed (U.S.): July 28, 2000
Page 2 of 6

STATEMENT OF FACTS

On July 3, 2002, the Notice (a copy of which is Attached hereto as **Exhibit A**) was mailed from the USPTO to Applicants' Agent. The Notice was received by Applicants' Agent on July 10, 2002. According to the Notice, a response was due one month from the date of mailing (August 3, 2002), extendable under the provisions of 37 C.F.R. § 1.136 (final due date January 3, 2003).

On July 18, 2002, Applicants' Agent timely filed a response to the Notice via hand delivery with the USPTO. A copy of the July 18, 2002 response, including a copy of the unstamped return receipt postcard filed with the response, is attached hereto as **Exhibit B**. The return receipt postcard was stamped by the USPTO on July 18, 2002, indicating timely receipt by the USPTO of Applicants' response to the Notice. A copy of the postcard date-stamped by USPTO on July 18, 2002, is attached hereto as **Exhibit C**.

On May 1, 2003, a Telephone conference was conducted between Applicants' Agent Jennifer Rosenfield and Examiner Samuel Liu. Examiner Liu indicated that no response to the Notice had been filed, and that the application would be abandoned for failure to respond. A miscommunication between Agent Rosenfield and Examiner Liu led Agent Rosenfield to believe that, in addition to the Notice dated July 3, 2002, a second Notice had been issued by the USPTO on July 30, 2002. Agent Rosenfield therefore indicated that this second Notice had not been received by Applicants' Agent, and therefore, that no response had been filed.

At Agent Rosenfield's request, Examiner Liu transmitted (via facsimile) a copy of the outstanding Notice issued by the USPTO to Agent Rosenfield. This facsimile was received by Agent Rosenfield on May 1, 2003. The facsimile, however, contained the original Notice of July

Attorney Docket No. 57109 (71699)
U.S.S.N. 09/627,600
Filed (U.S.): July 28, 2000
Page 3 of 6

3, 2002 (rather than July 30, 2003), indicating that there was indeed only one Notice, dated July 3, 2002, to which Applicants had in fact responded.

A copy of the above-referenced facsimile is attached hereto as **Exhibit D**. It should be noted that the second page of this facsimile, which corresponds to the front page of the original Notice, contains the docketing stamp of Applicants' Agent, Edwards & Angell, LLP. The presence of this docketing stamp indicates that this copy of the Notice (i.e., the copy faxed by Examiner Liu) must have originated with Applicants' Agent as part of a response to the Notice, and accordingly proves that a response to the Notice must have been filed and received by the USPTO. Additionally, there is a USPTO OIPE date stamp on this copy of the Notice, indicating receipt by the USPTO on July 18, 2002, as well as a Tech Center 1600/2900 "Received" stamp indicating a receipt by the Examining group on July 24, 2002. The presence of the Edwards & Angell stamp, the OIPE stamp, and the Tech Center stamp indicates that the copy of the Notice in Examiner Liu's possession must have been derived from Applicant's response to the Notice, and therefore, that said response was timely filed.

On May 27, 2003, Applicants' Agent filed a Supplemental Response to the Notice via hand delivery, setting forth a subset of the above-iterated facts. A copy of the receipt acknowledgement form date-stamped by the USPTO is attached hereto as **Exhibit E**.

On June 13, 2003, a Notice of Abandonment (Paper No. 16) was mailed from the USPTO. This Notice was received by Applicants' Agent on June 16, 2003. A copy of the Notice of Abandonment is attached hereto as **Exhibit F**. (It should be noted that the Notice of Abandonment indicates abandonment for failure to timely respond "to the Office letter mailed on 3 July 2003." This appears to be a typographical error, given that the Notice of Abandonment was mailed prior to July 3, 2003. Applicants assume the date was meant to read July 3, 2002.)

Attorney Docket No. 57109 (71699)

U.S.S.N. 09/627,600

Filed (U.S.): July 28, 2000

Page 4 of 6

According to the Notice of Abandonment, "On communication with Jennifer Rosenfield on behalf of Peter F. Corless on May 1, 2003, it is conformed (*sic*) that applicants did not respond to the Office action mailed 3 July 2002." (See bottom of page, under "7. The reason(s) below:") Applicants wish the record to reflect that Agent Rosenfield was under the impression that a second action had been mailed on 30 July 2002 because of a miscommunication with Examiner Liu (see above). It was that purported action to which she agreed that Applicants had not responded. Agent Rosenfield never confirmed that Applicants did not respond to the Office action (the Notice) of July 3, 2002. As the evidence presented herein shows, Applicants did indeed respond to that Notice.

It should further be noted that the July 3, 2002 Notice was assigned Paper No. 13 by the USPTO, and the June 13, 2003 Notice of Abandonment was assigned Paper No. 16 by the USPTO. This numbering sequence could only have been possible if the USPTO did in fact receive Applicants' timely filed response of July 18, 2002, according to the following logic: Applicants are aware of no other Notices mailed from the USPTO in the intervening length of time between Papers No. 13 and 16. Accordingly, Papers No. 14 and 15 could only have been assigned to the two intervening communications filed by Applicants: the response to the Notice filed July 18, 2002, and the supplemental response filed May 27, 2003. This is further evidence that the USPTO did in fact receive Applicants' response to the Notice.

RELIEF REQUESTED BY APPLICANTS

Based on the foregoing evidence, Applicants respectfully request that the Commissioner (1) withdraw the holding of abandonment of this application, and (2) enter the enclosed copy of the response of July 18, 2002.

Attorney Docket No. 57109 (71699)
U.S.S.N. 09/627,600
Filed (U.S.): July 28, 2000
Page 5 of 6

REQUIRED FEE

There is no fee required in furtherance of the submission of a Petition pursuant to 37 C.F.R. § 1.181. Moreover, a fee is not believed to be required for consideration of the instant Petition because it addresses an error that is not attributable to Applicants or Applicants' Agent. However if for any reason an fee(s) is/are required to be submitted to enable consideration of the instant Petition, the Commissioner is hereby authorized and requested to charge Deposit Account No. 04-1105 for the full amount of such fee(s).

TIMELY FILING OF THE INSTANT PETITION

The instant Petition is being submitted prior to the expiration of two months from the date of mailing of the Notice of Abandonment. Accordingly, Applicants submit that the instant Petition is timely filed, and respectfully request consideration of the Petition by the Commissioner.

ALTERNATIVE PLEADING

In the event that the USPTO dismisses the instant Petition for any reason, or refuses to grant the relief requested above by Applicants, Applicants respectfully request that the instant Petition be considered as a conditional petition pursuant to 37 C.F.R. § 1.137(a) to request revival of an application because of an unavoidable delay.

Attorney Docket No. 57109 (71699)
U.S.S.N. 09/627,600
Filed (U.S.): July 28, 2000
Page 6 of 6

If the instant Petition is considered pursuant to 37 C.F.R. § 1.137(a), then the Commissioner is hereby authorized and requested to charge Deposit Account No. 04-1105 for any required fee(s) pursuant to 37 C.F.R. § 1.17(l).

Respectfully submitted,

Date: July 9, 2003



Jennifer Rosenfield, Reg. No. 53,531
Agent for Applicants
Intellectual Property Practice Group of
EDWARDS & ANGELL LLP
P.O. Box 9169
Boston, MA 02209

BOS2_340635.1